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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/672,421

09/26/2003

Todd A. Coble

905P178

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06/21/2005

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EXAMINER

CHAN, KO HUNG

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/672,421	<b>Applicant(s)</b> COBLE ET AL.	
	<b>Examiner</b> Korie H. Chan	<b>Art Unit</b> 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.  
 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
     4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-15 and 19-21 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of the specie of figures 1-8, claims 1-15 and 19-21 in the reply filed on March 28, 2005 is acknowledged. The traversal is on the ground(s) that group I and group II are not independent. This is not found persuasive because in this species requirement are based on the fact that they have different mounting assemblies. Applicant has not clearly shown or demonstrated that the different mounting assemblies are obvious variants of each other as stated in the election requirement (page 2, last paragraph). Indeed, applicant has specifically stated that "the difference is that between group I and group II employ different mount assemblies" (Page 2, paragraph B, lines 6-7).

The requirement is still deemed proper and is therefore made FINAL.

Claims 16-18 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 28, 2005.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8, line 3, "bracket assembly" does not have

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antecedent basis. Claim 14, line 2, "a first side" should be corrected to "said first side".

Claim 15, "the plurality of connectors" lack proper antecedent basis. It appears claim 15 should have been dependent on claim 14.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Bell et al (US patent no. 6,545,216). Bell discloses a ceiling fixture support assembly for mounting electrical fixtures such as fan and lighting fixtures (col. 1, lines 20-22) comprising electrical box (18) including a base member of disk shaped (16) with parallel beveled edges (where 70 and 40 are mounted) with side member (18), first and second fixture support (40 and 70) having a shaft (52) inserted into the flat portion of the side member and with connector holes (44, 48), and mounting assembly (fasteners not shown but to be used through holes (26, 28) to couple the electrical box to the structural support member. Claim 2 is purely functional and recites intended usage meaning that electrical box is capable of being coverable by a cover. Bell's electrical

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box inherently is capable of receiving a cover. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rugg (US patent no. 2,380,793) in view of Bell et al (US patent no. 6,545,216). Rugg discloses a ceiling fixture support assembly for mounting electrical fixtures comprising electrical box (2) including a base member (4 and 7) of disk shaped (4) with parallel beveled edges (3) with side member (2, figure 2), wherein the base member (4 and 7) has slots (10) for receiving a U-shaped mounting assembly (8)

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having a rectangular flat support member (13, figure 3), plural tabs (14) insert into slots. However, Rugg does not show the claimed first and second support fixture assembly.

Bell teaches a ceiling fixture support assembly for mounting electrical fixtures such as fan and lighting fixtures (col. 1, lines 20-22) comprising electrical box (18) including a base member of disk shaped (16) with parallel beveled edges (where 70 and 40 are mounted) with side member (18), first and second fixture support (40 and 70) having a shaft (52) inserted into the flat portion of the side member and with connector holes (44, 48), and mounting assembly (fasteners not shown but to be used through holes (26, 28) to couple the electrical box to the structural support member.

It would have been obvious to one of ordinary skill in the art to have provided Rugg's fixture support assembly with Bell's first and second fixture support for supporting ceiling and lighting fixtures as taught to be desirable by Bell. Regarding claim 2, Rugg's electrical box is inherently capable of receiving a cover.

Claims 12 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Rugg (US patent no. 2,380,793) in view of Bell et al (US patent no. 6,545,216) as applied to claims 1, 6, 8, 11 above, and further in view of Reiker (US patent no. 6,207,897). Rugg and Bell combined disclosed all the claimed features of applicant's invention except for being mounted to a joist and using plural connectors to connect the flat member to the base member. Reiker teaches an electrical box ceiling fixture with U-shaped mounting assembly having tabs (521, 522) for mounting to a joist (J) wherein the flat member of the U-shaped is mounted to the base member via plural connectors (554). It would have been obvious to one of ordinary skill in the art to have mounted the

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ceiling fixture of Rugg and Bell to a ceiling joist via the U-shaped mounting assembly and to mount the flat member using plurality of connectors for a more secure fit as taught to be desirable by Reiker.

***Allowable Subject Matter***

Claims 10, 13, and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The remaining prior art discloses ceiling fixtures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on 571-272-6815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Korie H. Chan  
Primary Examiner  
Art Unit 3632

khc

June 16, 2005